



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/608,981

06/27/2003

Robert Keane

MPJ-D2

6395

37420

7590

09/17/2010

VISTA PRINT USA, INC.
ATTN: PATENT COUNSEL
95 HAYDEN AVENUE
LEXINGTON, MA 02421

EXAMINER

LASTRA, DANIEL

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

09/17/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/608,981	Applicant(s) KEANE ET AL.	
	Examiner DANIEL LASTRA	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 and 3-22 have been examined. Application 10/608,981 (PRODUCT PRICING SYSTEM AND METHOD) has a filing date 06/27/2003 is a division of 09557571 (Pat. 6650433)(04/25/2000) and foreign priority 01/25/2000.

Response to Amendment

2. In response to BPAI decision filed 03/03/10, the Applicant filed an RCE on 05/03/10, which amended claims 1, 8, cancel claim 2 and added new claims 9-22.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274) in view of Popat (US 6,117,061).

Claims 1, 11 and 17 Ryan teaches:

A computer-implemented product design method comprising providing one or more product design software tools, the tools being adapted *to provide a product tools to the user, the product tools incorporating an advertisement not provided by the user, the tools further adapted to allow the user to incorporate user content into the tools* (see col 9, lines 10-25; see figure 3) to create an electronic product design (see col 12, lines

Art Unit: 3688

22-35) offering the user the option of removing the advertisement (see col 9, lines 10-25). Ryan does not teach that said tool is a template. However, Popat teaches that it is old and well known in the promotion to use design software tools that are templates in order to allow a user to add or remove advertisements from a printed product prior to printing said product, where said advertisements can be obtained from external sources from said user (see col 2, lines 40-50; col 5, line 55 – col 6, line 20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Ryan would include software templates to design his custom-printed documents, as taught by Popat as the claimed invention is merely a combination of old elements and in the combination each element would have performed the same function separately and one of ordinary skill would have recognized that the results of the combination were predictable.

Claims 3, 12, 18 Ryan teaches:

wherein the user must pay a fee to have the advertisement removed (see col 9, lines 10-25; col 10, lines 5-15).

Claims 4, 13, 19 Ryan does not expressly teach:

wherein the tools are provided by a business to the user at no charge and wherein the advertisement is a promotional message for the business providing the tools. However, Official Notice is taken that it is old and well known in the promotion art that manufacturers pay to insert their ads in flyers or printed papers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Ryan's postage meter manufacturers (i.e. business) would be

Art Unit: 3688

motivated to pay users for inserting said manufacturers' ads into said users' envelopes in order to give said users an incentive to participate in said manufacturers' system.

Claims 5, 8-10, 14, 20 Ryan teaches:

wherein the electronic product design is the design of a product that the user desires to be produced in physical form and wherein the method further comprises offering to produce the physical product for the user at a first price if the advertisement appears on the produced product (see col 9, lines 10-25; col 10, lines 5-15); and

offering to produce the physical product for the user at a second price if the advertisement does not appear on the produced product, the second price being greater than the first price (see col 9, lines 10-25; col 10, lines 5-15).

As per claims 6, 15, 21 Ryan does not expressly teach:

wherein the first price is free. However, Official Notice is taken that it is old and well known in the promotion art that advertisers offer consumers products or services for free when said consumers accept to view or display advertisements in said products. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers in the Ryan's system would subsidize certain printing jobs by offering certain printing for free, as it is old and well known to offer user free products when said users are willing to view or display advertisements in said products.

Claims 7, 16, 22 Ryan teaches:

wherein the electronic product design is the design of a product intended to be printed and the physical product is a quantity of printed copies of the printed product (see figure 1, item 17).

Response to Arguments

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN WEISS can be reached on (571) 272-6812. The official Fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/
Primary Examiner, Art Unit 3688
September 16, 2010